

REMARKS

I. Status of Claims

The final Office Action mailed October 3, 2008 has been received and carefully considered. Claims 1-17, 19-21 and 23-37 are pending with claims 1, 19, 20, 31 and 37 being independent. In this response, previously presented claims 26-36 have been amended to correct for the inclusion of two claims that were both numbered claim 26. Accordingly, the second claim 26 and claims 27-36 have been renumbered as claims 27-37 respectively. No new matter has been introduced by way of the claim amendments. Entry of the amendments to the claims is respectfully requested. Reconsideration of the outstanding rejections in the present application is also respectfully requested based on the following remarks.

II. Response to Claim Rejections Under 35 U.S.C. §103(a)

Claims 1-17, 19-21 and 23-37 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 5,539,635 issued to *Larson, Jr.* (hereafter LARSON) in view of U.S. Patent No. 5,303,401 issued to *Duckeck et al.* (hereafter DUCKECK). The Examiner asserted that the cited references disclose the various features recited in the claims. Applicant respectfully disagrees.

Under 35 U.S.C. § 103, the Patent Office bears the burden of establishing a prima facie case of obviousness. *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). The Patent Office can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of references. *Id.* Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). That is, under 35 U.S.C. § 103, teachings of references can be combined only if there is some suggestion or motivation to do so. *Id.* However, the motivation cannot come from the applicant's invention itself. *In re Oetiker*, 977 F.2d 1443, 1447, 24 USPQ2d 1443, 1446 (Fed. Cir. 1992). Rather, there must be some reason, suggestion, or motivation found in the prior art whereby a person of ordinary skill in the art would make the combination. *Id.*

Regarding claim 1, Applicant has carefully considered LARSON and DUCKECK in the context of 35 U.S.C. § 103 and submits that these references fail to establish *prima facie* obviousness of claim 1. Claim 1 recites:

A method for identifying at least one broadcast provider through a combination of a geographic identification code and a broadcast identifier, the method comprising:

- digitally storing in a database one or more geographic identification codes that are each associated with at least one area or location in which a broadcast is receivable from at least one broadcast provider;
- digitally storing in the database one or more broadcast identifiers that are each associated with at least one broadcast provider;
- receiving at least one user related geographic identification code;
- receiving at least one user related broadcast identifier, wherein the received at least one user related broadcast identifier is not required to *by itself* identify a broadcast provider;
- communicating the received at least one user related geographic identification code into the database to determine a subset of data, the subset of data comprising at least one of the stored one or more broadcast identifiers that are associated with at least one of the stored one or more geographic identification codes that corresponds to the received at least one user related geographic identification code; and
- identifying at least one broadcast provider using at least both the subset of data and the received at least one user related broadcast identifier, wherein the identifying of the at least one broadcast provider does not require identifying only a closest proximity broadcast provider based on the received at least one user related geographic identification code (emphasis added).

Feature not Taught or Suggested

As stated in MPEP § 2143.03, to establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). That is, “[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art.” In re Wilson, 424 F.2d 1382, 165 USPQ 494, 496 (CCPA 1970).

In particular, applicant submits that at the least, the combination of LARSON and DUCKECK, taken either alone or in combination, fails to disclose, or even suggest:

**receiving at least one user related broadcast identifier,
wherein the received at least one user related broadcast
identifier is not required to *by itself* identify a broadcast
provider** (hereafter referred to as the Broadcast ID feature)

and

**identifying at least one broadcast provider using at least
both the subset of data and the received at least one user
related broadcast identifier** (hereafter referred to as the
Identifying feature)

LARSON discloses a radio program distribution system that is adapted to interact with a customer through a telephone to facilitate a purchase of a compact disc relating to a radio program that a customer heard on a radio. As part of the telephonic interaction, LARSON's radio program distribution system receives certain items of information from the customer in order to locate a data entry in a database that corresponds to a radio program the customer is interested in. The items of information consist of time, date and broadcaster and all three of time, date and broadcaster are required. Once received by the radio program distribution system, the system uses the three items of information to match a corresponding entry in a Broadcast Table (shown in Fig. 3). Once the corresponding entry in the Broadcast Table is located, a Reference Tag is obtained. The Reference Tag is then used to match a corresponding entry in a Program Table (shown in Fig. 2) which contains information about the radio program the customer is inquiring about.

LARSON's radio program distribution system requires that the information received from the customer include all three items of information, namely the time, date and broadcaster. The system only has a single entry in the Broadcast Table for any given combination of time, date and broadcaster. With respect to the broadcaster information received from the customer, LARSON teaches that either the broadcaster identity is received from the customer or the customer selects the broadcaster identity through a menu. In either case, when the customer provides the broadcaster identity to the system, the provided broadcaster identity *by itself* identifies the broadcaster.

In contrast, Applicant's claim 1 recites the above identified Broadcast ID and Identifying features. Since LARSON's system operates under the assumption that the provided broadcaster

identity *by itself* identifies the broadcaster, there is no need in LARSON's system to be able to receive broadcaster information from a user that is not required to *by itself* identify the broadcaster. Accordingly, LARSON's system does not include any capability for the receipt of broadcaster information from the customer that is not required to *by itself* identify the broadcaster. Instead, LARSON's system uses the exact broadcaster identity provided by the customer to match the appropriate entry in the database. If LARSON's system received broadcaster information that is not required to by itself identify the broadcaster, the system will not be able to locate an entry in the database since there will be no direct match between the received broadcaster information and the broadcaster identity used in the database. Accordingly, LARSON fails to teach or disclose the Broadcast ID and Identifying features. Furthermore, the Examiner has previously conceded that LARSON fails to teach or disclose the Broadcast ID.

Applicant notes that arguments directed at the Broadcast ID feature (or features similar thereto) as it pertains to LARSON have been previously presented. A brief history is provided hereafter for the Examiner's convenience. Claim 1 was initially amended to include the Broadcast ID (or features similar thereto) in the amendment filed September 14, 2007 which further included arguments directed thereto that LARSON failed to disclose, or even suggest, the Broadcast ID (or features similar thereto). In response, the Examiner issued a new rejection under 35 U.S.C. § 103(a) on January 30, 2008. In the third paragraph of section two (2) of the Office Action, the Examiner conceded that LARSON failed to disclose, or even suggest, the Broadcast ID (or features similar thereto) and that U.S. Patent No. 5,561,704, issued to *Salimando*, was cited to make up for LARSON's deficiencies. Applicant once again submitted arguments directed at the Broadcast ID feature on June 30, 2008. In response, the Examiner issued the outstanding office action on October 3, 2008, in which DUCKECK was substituted for *Salimando*. In the outstanding office action it is once again conceded that LARSON fails to teach or disclose the Broadcast ID feature.

However, the current rejection is silent as to what if anything reads on the Broadcast ID feature. Since, the Examiner has already conceded that LARSON fails to disclose, or even suggest, the Broadcast ID feature, it falls upon DUCKECK to make up for LARSON's deficiencies with respect to the Broadcast ID feature. However, DUCKECK was cited by the examiner to make up for LARSON's deficiencies as it pertains to features related to geographic

identification and not the Broadcast ID feature. In addition, a review of DUCKECK leads to no natural interpretation, taken either alone or in combination with LARSON, which would disclose, or even suggest, the Broadcast ID feature.

DUCKECK discloses a mobile radio receiver that is able to filter Radio Data System (RDS) information, based on the region the mobile radio receiver is determined to be located in, in order to only display RDS information that corresponds to the determined region. The mobile radio receiver determines the region the mobile receiver is located in by scanning for all frequencies on which a signal is being received. By comparing a result of the scan to stored information, the mobile radio receiver is able to determine the region the mobile radio receiver is located in and thereby is able to filter the received RDS information so that only RDS information that pertains to the determined region is displayed. DUCKECK does not disclose receiving a user related broadcast identifier let alone a user related broadcast identifier that is not required to *by itself* identify a broadcast provider. Clearly, DUCKECK fails to disclose, or even suggest the Broadcast ID feature in the context of claim 1.

Thus, LARSON and DUCKECK, taken either alone or in combination, fails to disclose, or even suggest the Broadcast ID feature in the context of claim 1. Accordingly, since the Broadcast ID feature is neither disclosed nor suggested by the cited references, the Identifying feature, which depends on the Broadcast ID feature, **cannot** be disclosed or suggested by the cited references. Therefore, since all of the claim features are not taught or suggested by the cited references, it is respectfully submitted that the combination of LARSON and DUCKECK fails to establish *prima facie* obviousness of claim 1. Should the Examiner maintain the rejection the Examiner is respectfully requested to articulate in detail how LARSON and DUCKECK are being interpreted to anticipate the Broadcast ID and Identifying features of claim 1.

Impermissible Hindsight

As stated in MPEP § 2143.01, obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

Applicant submits that there is insufficient motivation for the combination of LARSON and DUCKECK. Furthermore, Applicant submits that the combination is based on impermissible hindsight reconstruction, and not on the objective teachings of LARSON and DUCKECK. "When determining the patentability of a claimed invention which combines two known elements, the question is whether there is something in the prior art as a whole to suggest the desirability, and thus obviousness, of making the combination." *Id.* at *29-30 (citing *In re Beattie*, 974 F.2d 1309, 1311-12, 24 USPQ2d 1040, 1042 (Fed. Cir. 1992)).

In this case, the Examiner's combination appears to be a combination of generalizations from LARSON and DUCKECK that are divorced from the specifics of their teachings and suspiciously fit together so as to formulate something that resembles the Applicant's claim 1. Distilling an invention down to the "gist" or "thrust" of an invention disregards the requirement of analyzing the subject matter "as a whole." *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). However, the Applicant submits that even the generalizations of LARSON and DUCKECK do not lend themselves to be combined in a manner consistent with claim 1.

LARSON's teaching is directed toward facilitating the purchase of a compact disc including a radio program that a customer heard on the radio. LARSON addresses the problem of user convenience in the purchasing of a compact disc relating to a radio program. In contrast, DUCKECK is directed toward filtering RDS information at a mobile radio receiver so that only RDS information that corresponds to a region the mobile radio receiver is located in is displayed. DUCKECK addresses the inconvenience to the user of displaying RDS information that does not correspond to a region in which the mobile radio receiver is located. Further, DUCKECK addresses the problem of how to determine the region in which the mobile radio receiver is located.

One of ordinary skill in the art would not arrive at the features of claim 1 based on LARSON and DUCKECK absent hindsight reasoning. Neither LARSON nor DUCKECK suggest a problem that is overcome by the other. Further, one of ordinary skill in the art trying to

solve the problem addressed by the claims would neither consider LARSON and DUCKECK to solve the problem, nor combine LARSON and DUCKECK in the manner set forth by the rejection if LARSON and DUCKECK were considered. The Examiner has not identified or suggested how one might blend all of the various concepts in LARSON and DUCKECK. LARSON is implemented in a non-mobile central system involving telephonic communication with a user while DUCKECK is implemented in a mobile radio receiver without direct interaction with a user. LARSON determines program information based on known time, date and broadcaster information and DUCKECK determines a geographic region in which a mobile radio receiver is located and filters RDS information based on the determined region. Considering the entire teachings of LARSON and DUCKECK it is hard to envision how or why LARSON and DUCKECK could be combined in a manner consistent with the claim 1.

Accordingly, it is clear that the Examiner's combination fails to consider the objective teachings of the cited references as a whole and instead uses the Applicant's teaching as a roadmap for picking and choosing generalizations from LARSON and DUCKECK to formulate something that resembles the Applicant's claim 1. Accordingly, it is clear that the Examiner's combination can only be based on impermissible hindsight reconstruction. Therefore, since the rejection of Applicant's claim 1 is based on impermissible hindsight reconstruction, it is respectfully submitted that the combination of LARSON and DUCKECK fails to establish *prima facie* obviousness of claim 1.

Unsatisfactory Modification for Intended Purpose

As stated in MPEP § 2143.01, if the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). Further, if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959).

In this case, LARSON is directed to a radio program distribution system that is adapted to interact with a customer through a telephone to facilitate the purchase of a compact disc related

to a radio program that a customer heard on a radio. As part of that interaction, LARSON's radio program distribution system receives three items of information, namely the time, date and broadcaster, from the customer in order to locate a data entry in a database that corresponds to a radio program the customer is interested in. Once received by the radio program distribution system, the system uses the three items of information to match a corresponding entry in a Broadcast Table (shown in Fig. 3). Once the corresponding entry in the Broadcast Table is located, a Reference Tag is obtained. The Reference Tag is then used to match a corresponding entry in a Program Table (shown in Fig. 2) which contains information about the radio program the customer is inquiring about. In LARSON's radio program distribution system, the system requires that the information received from the customer include all three items of information, namely the time, date and broadcaster. The system only has a single entry in the Broadcast Table for any given combination of time, date and broadcaster. LARSON's radio program distribution system includes no provision to consider geographical information.

DUCKECK discloses a mobile radio receiver that is able to filter Radio Data System (RDS) information, based on the region the mobile radio receiver is determined to be located in, in order to only display RDS information that corresponds to the determined region. The mobile radio receiver determines the region the mobile receiver is located in by scanning for all frequencies on which a signal is being received. By comparing a result of the scan to stored information, the mobile radio receiver is able to determine the region the mobile radio receiver is located in and thereby is able to filter the received RDS information so that only RDS information that pertains to the determined region is displayed. Thus, DUCKECK is intended to filter RDS information based on a location of a mobile radio receiver and/or is intended to determine a location of a mobile radio.

However, the Examiner's combination of DUCKECK with LARSON would render DUCKECK as being modified unsatisfactory for its intended purpose because neither the part of DUCKECK being combined nor the resulting combination would be able to filter RDS information based on a location of a mobile radio receiver and/or be able to determine a location of a mobile radio. Thus, there is no suggestion or motivation to make the proposed modification because the combination of DUCKECK with LARSON would render DUCKECK as being modified unsatisfactory for its intended purpose. Therefore, since the proposed modification

would render DUCKECK as being modified unsatisfactory for its intended purpose, it is respectfully submitted that the combination of LARSON and DUCKECK fails to establish *prima facie* obviousness of claim 1.

Therefore, for any of the above stated reasons, claim 1 is allowable over LARSON and DUCKECK. Should the rejection of claim 1 be maintained, the Examiner is respectfully requested to respond in detail to each of the above arguments.

Regarding claims 2-17, 28 and 29, these claims are dependent upon independent claim 1. Thus, since independent claim 1 should be allowable as discussed above, claims 2-17, 29 and 30 should also be allowable at least by virtue of their dependency on independent claim 1. Moreover, these claims recite additional features that are not disclosed, or even suggested, by the cited references taken either alone or in combination.

Regarding independent claims 19, 20, 31 and 37, these claims recite subject matter related to claim 1. In particular, claim 19 recites:

wherein the at least one user communication comprises at least one user related broadcast identifier that is not required to by itself identify the at least one broadcast provider
and
identifying at least one broadcast provider using both said retrieved indexed one or more broadcast identifiers and said received at least one user related broadcast identifier

Claim 20 recites:

wherein said received at least one user related broadcast identifier is not required to by itself identify a broadcast provider
and
for identifying at least one broadcast provider using at least both the subset and the at least one user related broadcast identifier received by the processor

Claim 31 recites:

wherein the received at least one user related content provider identifier is not required to by itself identify a content provider

and

identifying at least one content provider using at least both the subset of data and the received at least one user related content provider identifier

Claim 37 recites:

wherein the received at least one user related broadcast identifier is not required to by itself identify a broadcast provider

and

identifying at least one broadcast provider using at least the database, the received at least one user related geographic identification code and the received at least one user related broadcast identifier

Thus, the arguments set forth above with respect to claim 1 are similarly applicable to independent claims 19, 20, 31 and 37. Accordingly, is it respectfully submitted that independent claims 19, 20, 31 and 37 are allowable over LARSON and DUCKECK for similar reasons as set forth above with respect to independent claim 1.

Regarding claims 20-21, 23-30 and 32-36, these claims are dependent upon independent claims 19, 20, 31 and 37. Thus, since independent claims 19, 20, 31 and 37 should be allowable as discussed above, claims 20-21, 23-30 and 32-36 should also be allowable at least by virtue of their dependency on independent claims 19, 20, 31 and 37. Moreover, these claims recite additional features that are not disclosed, or even suggested, by the cited references taken either alone or in combination.

III. Conclusion

In view of the foregoing, it is respectfully submitted that the present application is in condition for allowance, and an early indication of the same is courteously solicited. The Examiner is respectfully requested to contact the undersigned by telephone at the below listed telephone number, in order to expedite resolution of any issues and to expedite passage of the present application to issue, if any comments, questions, or suggestions arise in connection with the present application.

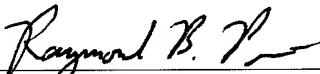
To the extent necessary, a petition for an extension of time under 37 CFR § 1.136 is hereby made.

It is believed that no additional fees are due in connection with the filing of this Amendment. However, please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 50-4100, and please credit any excess fees to the same deposit account.

Respectfully submitted,

JEFFERSON IP LAW, LLP

Date: January 6, 2009

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